The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NOBUYUKI KUZUTA

Appeal No. 2000-0737 Application No. 08/919,795

ON BRIEF

Before URYNOWICZ, JERRY SMITH and DIXON, <u>Administrative Patent</u> <u>Judges</u>.

URYNOWICZ, Administrative Patent Judge.

Decision on Appeal

This appeal is from the final rejection of claims 1-4.

The invention pertains to laser apparatus. Claim 1 is

illustrative and reads as follows:

- 1. A solid state laser device comprising:
- a laser semiconductor for oscillating a light as a pumping light,
- a collimator lens for leading the laser light to parallel rays,

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> a focusing lens for the laser light led to the parallel rays by the collimator lens and leading the focused laser light to a laser medium,

the laser medium for absorbing the laser light and outputting a spontaneous emission light, and

an optical resonator for confining the spontaneous emission light to make the laser light oscillated by an induced emissions,

wherein the solid state laser device includes a first housing for storing the laser semiconductor and the collimator lens in a state of positioning them on the same optical axis, and a second housing for storing the focusing lens, the laser medium and the optical resonator in a state of positioning them on the same optical axis, and the housings are detachable.

The reference relied upon by the examiner is:

Clark et al. (Clark)

4,730,335 Mar. 08, 1988

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark.

The respective positions of the examiner and the appellant with regard to the propriety of this rejection is set forth in the examiner's answer (Paper No. 13) and the appellant's brief and reply brief (Paper Nos. 12 and 14, respectively).

Appellant's Invention

The invention is described at pages 2 and 3 of the brief.

Opinion

After consideration of the positions and arguments presented by both the examiner and the appellant, we have concluded that the rejection should not be sustained.

The burden initially is on the examiner to show a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Here, it is considered that the examiner has not carried that burden. More specifically, with respect to Figure 4 of Clark, it is considered that the examiner has not provided a motivation or suggestion as to why one of ordinary skill in the art would have modified Clark by substituting two lenses, a collimating lens in fitting 27 and a focusing lens in fitting 28, for the lens 22 in fitting 27. The examiner's observation that the two proposed lenses are equivalent to and would perform the same function as Clark's lens 22 is not controlling because that fact, by itself, is not motivation to make the change suggested by the examiner. In fact, no motivation for making the suggested changes in Clark has been given in the answer.

Even if one were to substitute the equivalent pair of lenses suggested by the examiner into Clark for lens 22, both lenses would have been positioned in fitting 27, because that is wherein lens 22 is located. No motivation has been given for placing a collimating lens in fitting 27 and a focusing lens in fitting 28.

The fact that Clark may have been modified in the manner suggested by the examiner does not make the modification obvious

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unless the prior art suggested the desirability of the modification. <u>In re Fritch</u>, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

REVERSED

STANLEY M. URYNOWICZ,	JR.)
Administrative Patent	Judge)
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JERRY SMITH) INTERFERENCES
Administrative Patent	Judge)
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JOSEPH L. DIXON)
Administrative Patent	Judge)

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NIKAIDO MARMELSTEIN MURRAY & ORAM METROPOLITAN SQUARE 655 15TH STREET, NW SUITE330 G STREET LOBBY WASHINGTON, DC 20005-5701